

of this case, and any required fee for such extension in excess of the amount paid by check is to be charged to Deposit Account No. 16-2372.

Claim 1-18 are pending in the application.

Attached hereto is a substitute first page of the Specification. It is respectfully submitted that the substitute page perfects Applicant's claim to priority under 35 U.S.C. §119(e). It is also submitted that the substitute page does not introduce new matter into the application. A machine generated redline version of the page 1 indicating the changes made in arriving at the substitute page 1 is also attached.

Moreover, attached hereto is a Request for Approval of Drawing Corrections, with proposed corrections to Figs. 3, 4(a), 4(b), and 11, denoted in red manuscript. The Examiner is respectfully requested to acknowledge receipt and to indicate approval of the proposed drawing corrections in the next Patent Office Paper.

The Office Action rejects claims 1-5, 7, 9-12, 14-16, and 18 under 35 U.S.C. §103(a) as being unpatentable over Eberhardt (U.S. Patent No. 5,832,488) in view of Garcia (5,065,315). Moreover, claims 6, 8, 13, and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over the '488 patent in view of the '315 patent and further in view of the Sujansky Journal Article (hereinafter simply Journal Article). These rejections are respectfully traversed.

The '488 patent to Eberhardt teaches a truly paperless medical records system wherein all patient information resides on either a computer data base or a magnetic card. See Abstract. Moreover, the '488 patent teaches incentives for motivating the health care

service providers to enter all data electronically rather than on paper. See column, lines 17-25, which states that:

"Incentives must exist for the physician or other health care provider to input the results of each exam of every patient on to the SD or SDC (which currently desirably is a magnetic storage medium, easily "read" by modern computers). It is thought that the CDF will, itself, receive sufficient drug data to pay for such inputting of data. In addition, such SD cards will provide safer and less expensive medical care, so health insurers and malpractice insurers are certain to provide for the cost of inputting."

The '315 patent to Garcia teaches a hospital-wide computer system permitting entry of data regarding a patient's stay in the hospital. The system prints a history and physical report for the patient's chart and highlights the abnormal findings and complaints. The system additionally schedules all hospital services for the patient, thereby eliminating this responsibility from the nurses and other hospital personnel, and avoids situations where the patient is scheduled to be in two places at the same time. Test results and/or technicians's comments are entered into the system through department terminals; the results and comments, as well as physician's and nurses' notes and findings, are entered into the systems and printed at the nurses' station for inclusion in the chart. See Abstract.

Before addressing the rejections in detail, it should be mentioned that the Office Action relies on selected portions of, for example, column 18 of the '488 patent and columns 31 and 32 of the '315 patent. It is well settled that this tactic is *prima facie* erroneous, e.g., rejecting independent claim 1 of the instant application on the basis of claim 15 of the '315 patent amounts to *prima facie* error. This is a clearly indefensible tactic. The scope of patent's claims determines what infringes the patent; it is no measure of what it discloses. A patent discloses only that which it describes whether specifically or in general terms, so as to convey intelligence to one capable of understanding. While it is true that a claim is part of the disclosure, that point is of significance principally in the

situation where a patent application as filed contains a claim which specifically discloses something not disclosed in the descriptive part of the specification (claims being technically part of the specification). See In re Bennow (226 U.S.P.Q. 683, 6 (Fed. Cir. 1985). The Office Action has not conclusively established that this is the case with respect to any of the applied references. In short, the Office Action cannot rely on the claims in a patent reference as teaching a specific element of a pending claim.

Turning to the substantive issues, it is well settled that 35 U.S.C. §103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. §103, the Examiner should set forth in the Office action (1) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or differences in the claim over the applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made. See M.P.E.P. §706.02(j).

With respect to Item (4) above, i.e., it is respectfully submitted that the Office Action has not forth any motivation for the combination. The Office Action merely opines that it would have been obvious to combine the features of the '315 patent within the patient record of the '488 patent with the motivation of allowing a health care specialist to quickly ascertain important facts about a patient using the critical information file taught by the '488 patent (Column 7, lines 56-60), and increasing the efficiency and reducing the paperwork required to update a paper patient chart. In other words, the motivation set forth in the Office Action calls for the destruction of the features and operating methodology of the '488 patent to Eberhardt.

It is black letter law that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See M.P.E.P. § 2143, *citing In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Here, the combination would reintroduce the concept of working with paper files, a concept that the '488 patent teaches away from. Moreover, it is well settled that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention, i.e., the primary reference, being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. See M.P.E.P. § 2143, *citing In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959).

Thus, irrespective of whether one considers the teaching of the '315 patent as changing or simply modifying the operating principle of the primary reference to Eberhardt, the teaching of the '488 patent would not survive combination with the '315 patent. In other words, the Office Action has not set forth cogent reasoning for the combination given the actual teachings of the applied references.

Moreover, it is respectfully submitted that the Office Action has not set forth a "prima facie" case of obviousness since the Office Action has not even addressed the express limitation found in claim 1 regarding "wherein the information in the VPR [vital patient record] takes precedence over corresponding information in the HCPR [hard copy patient record]." The Office Action admits that this limitation is not taught by the '488 patent. However, the Office Action fails to address where this express recitation can be found in the '315 patent. Applicant respectfully submits that this recitation is not found within the four corners of the '315 patent. In short, neither of the applied references teach or suggest such a feature. Since neither of the applied reference teach this express feature of the

present invention, no possible combination of the applied references could render the invention of claim 1 obvious.

For all of the reasons enumerated above, the Examiner is respectfully requested to reconsider and withdraw the 35 U.S.C. §103(a) rejection of independent claim 1. Claims 2 and 3, depending from independent claim 1, are allowable for all of the reasons given with respect to claim 1.

With respect to independent claims 4, 11, and 15, it is respectfully submitted that the applied references, i.e., the '488 patent and the '315 patent, either alone or in combination, teach nothing with respect to "maintaining vital patient information complementing a hardcopy patient record (HCPR) maintained at a healthcare provider's office." The '488 patent completely dispenses with the concept of a HCPR and, thus, teaches away from any record that is complementary to the HCPR. The addition of the '315 patent to the combination would change the principle of operation of the '488 patent and, thus, cannot be made. Moreover, since both of the applied references would permit the dispensing of health service to a patient without his/her HCPR, the applied references teach nothing regarding any record "complementing" the HCPR, i.e., a feature common to claims 4, 11, and 15.

With respect to independent claim 4, it is respectfully submitted that the Office Action has not set forth a "prima facie" case of obviousness, since the Office Action has not established that the applied references, either alone or in combination, teach a step of "inserting a printed copy of the VPR whenever the HCPR is accessed in the healthcare provider's office." The Office Action merely asserts that the '488 patent teaches a printing function in block 25 of Fig. 2. This function is explained at column 15, lines 9-14 (rather than the portions of columns 7 and 9 actually cited in the Office Action) as

"Other main menu options allow printing 25 the contents of the window that is currently key, and saving 26 window contents to a text file. These commands operate on the window that is currently active and are standard in the well-known "windows" systems and thus, it is not necessary to elaborated them."

The Office Action fails to correct the admitted deficiency from the '488 patent with a teaching from the '315 patent. More specifically, column 10, lines 1-5, clearly indicate that the '315 patent permits information from the patient's last hospital stay to be accessed via a computer system 2 rather than retrieve the file from a warehouse. Thus, the '315 patent is, at best, silent as to "inserting a printed copy of the VPR whenever the HCPR is accessed in the healthcare provider's office." In actuality, the '315 patent reinforces the '488 patent in that the patient's records can be accessed via computer rather than accessing the actual hardcopy patient record, as specifically addressed in claim 4.

Furthermore, as globally asserted above with respect to the combination of the '488 patent and the '315 patent, these two references are not combinable, since the teachings of the '488 patent would not survive combination with the '315 patent.

For all of the reasons enumerated above, the Examiner is respectfully requested to reconsider and withdraw the 35 U.S.C. §103(a) rejection of independent claim 4. Claims 5, 7, and 9-10, depending from independent claim 4, are allowable for all of the reasons set forth with respect to independent claim 4.


With respect to claims 11 and 15, the combination of references applied in the Office Action fails to teach a function of "print[ing] a copy of the VPR for insertion into the HCPR whenever the HCPR is accessed in the healthcare provider's office," as discussed in detail with respect to independent claim 4. Thus, the Examiner is respectfully requested to reconsider and withdraw the 35 U.S.C. §103(a) rejection of claims 11 and 15. Claims 12

and 14, depending from independent claim 11, are allowable for all of the reasons given with respect to claims 4 and 11. Moreover, claims 16 and 18, depending from independent claim 11, are allowable for all of the reasons given with respect to claims 4 and 15.

With respect to claims 6, 8, 13, and 17, it is again respectfully submitted that the combination of the '488 patent and the '315 patent cannot render independent claims 4, 11, and 15 obvious, since (1) there is no motivation for the combination, i.e., the change in the operating principle of the '488 patent necessitated by the addition of the '315 patent demonstrates a *per se* lack of motivation, and (2) the combination fails to teach anything with respect to "print[ing] a copy of the VPR for insertion into the HCPR whenever the HCPR is accessed in the healthcare provider's office." Moreover, and in any event, the Journal Article is not cited as correcting, and does not correct, the deficiencies noted with respect to the '488 and '315 patent. Thus, the '488 patent, the '315 patent, and the Journal article, in any combination, could not possibly render the invention of claims 4, 11, and 15 obvious. That being the case, claims 6, 8, 13, and 18, are allowable for all of the reasons set forth with respect to claims 4, 11, and 15.

If any points remain in issue which the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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Attachments:

SERIAL NO.: 09/444,507

PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. §1.111

Substitute First Page of Specification
Redline Version of First Page
Request for Approval of Drawing Corrections

Date: September 24, 2002

Attorney Docket No.: VPR-001US



MACHINE GENERATED RED-LINE
VERSION OF THE
SPECIFICATION

VPR-001US
November 22, 1999

METHOD OF COORDINATING MAINTENANCE OF
VITAL PATIENT DATA AND
SOFTWARE THEREFOR

CROSS-REFERENCE TO RELATED APPLICATIONS

RECEIVED

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~~The present invention corresponds~~is patent application claims the invention is based
~~on~~benefit of priority, under 35 U.S.C. §119(e), to Provisional Patent Application No. 60/109,453,
which was filed on November 23, 1998, and which is incorporated, in its entirety, herein by
reference.

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BACKGROUND OF THE INVENTION

Field of the Invention:

The present invention relates to methodologies for gathering, archiving, and subsequent
retrieving and updating of patient healthcare information. More specifically, the present invention
relates to methods and corresponding software for creating a digital Vital Patient Record which
automates much of the gathering, archiving, retrieving and updating functions mentioned above. A
method of operating a Core Records System within the clinical environment is also disclosed.

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Description of the Related Art:

5 | Healthcare delivery throughout most of the world depends on or is interlinked with patient healthcare records. Moreover, just within the clinical environment, there are many tasks related to this information, which tasks include:

(1) gathering healthcare data;

(2) archiving the healthcare data;

10 (3) accessing the healthcare data, e.g., in preparation for an office visit;